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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,220	02/28/2006	Syed V. S. Kashmiri	42396664903	8168

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EXAMINER	
BLANCHARD, DAVID J	
ART UNIT	PAPER NUMBER
1643	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/570,220	KASHMIRI ET AL.	
	Examiner	Art Unit	
	David J. Blanchard	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-43* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

To have a general inventive concept under PCT rule 13.1, the inventions need to be linked by a special technical feature. The special technical feature recited in claim 1 is a humanized anti-TAG72 CC49 antibody comprising a light chain CDR1, CDR2, CDR3 and a light chain framework region from HuCC49V10, a heavy chain comprising a heavy chain CDR1, CDR2, CDR3 and a heavy chain framework region from HuCC49V10, wherein the light chain framework comprises a corresponding framework residue from human antibody LEN at positions 5, 19, 21 and 106 in the light chain, and wherein the heavy chain framework region comprises a corresponding framework residue from human antibody 21/28'CL at positions 20, 38, 48, 66, 67, 69 and 80 in the heavy chain, wherein the humanized antibody retains binding affinity for TAG-72. In view of this Gonzales et al (Proceedings of the American Association for Cancer Research, Annual meeting, vol. 44, pp. 1118, July 2003, IDS reference filed 2/28/06) reads on the claim. Gonzales et al teaches a variant of the HuCC49V10 antibody, termed V59, in which murine VL framework residues 5, 19, 21, 43, 78, 100 and 106 of huCC49V10 were replaced with the corresponding residues of the human antibody LEN and murine VH framework residues 12, 20, 38, 40, 48, 66, 67, 69 and 80 of huCC49V10 were replaced with the corresponding residues of the human antibody 21/28'CL as evidenced by Gonzales et al (Molecular Immunology, 40(6):337-349, October 2003). Therefore, the technical feature recited in claim 1 is not special. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-27, 36-37 and 42-43, drawn to a humanized anti-TAG72 CC49 antibody, a kit and a pharmaceutical composition comprising such.

Group II, claims 28-29, drawn to a method of treating a subject with a tumor that expresses TAG-72 comprising administering a humanized anti-TAG72 CC49 antibody.

Group III, claims 30-34, drawn to an *in vitro* method for detecting a cell expressing TAG-72 in a subject comprising contacting a sample from the subject with a humanized anti-TAG72 CC49 antibody, detecting the presence of a complex of the antibody with TAG-72, thereby detecting a cell expressing TAG-72.

Group IV, claim 35, drawn to a method for *in vivo* diagnosis of cancer in a subject comprising administering to a mammal a diagnostically effective amount of a detectable labeled humanized anti-TAG-72 CC49 antibody, allowing the antibody to localize and detecting the labeled antibody, thereby diagnosing cancer.

Group V, claims 38-41, drawn to DNA, vectors and host cells encoding a humanized anti-TAG72 CC49 antibody.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: As set forth above, in view of the teaching of Gonzales et al the groups are not so linked as to form a single general concept under PCT Rule 13.1 because the technical feature of claim 1 is not special.

Inventions of Groups I and V represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects. The antibody of Group I and the polynucleic acid of Group II are structurally and chemically different from each other. The antibody is raised by immunization, and the polynucleotide is made by nucleic acid synthesis. Furthermore, the antibody can be

used to immunopurify the antigen and the polynucleotide can be used for hybridization screening, for example. The examination of each group would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions I and V are patentably distinct.

The methods of Inventions II-IV differ in the method objectives, method steps and parameters and in the reagents used. Invention II recites a method of treating a subject with a tumor that expresses TAG-72 comprising administering a humanized anti-TAG72 CC49 antibody; Invention III recites an *in vitro* method for detecting a cell expressing TAG-72 in a subject comprising contacting a sample from the subject with a humanized anti-TAG72 CC49 antibody, detecting the presence of a complex of the antibody with TAG-72, thereby detecting a cell expressing TAG-72; Invention IV recites a method for *in vivo* diagnosis of cancer in a subject comprising administering to a mammal a diagnostically effective amount of a detectable labeled humanized anti-TAG-72 CC49 antibody, allowing the antibody to localize and detecting the labeled antibody, thereby diagnosing cancer. The examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus Inventions II-IV are separate and distinct in having different method objectives, method steps, parameters, reagents used and have different endpoints and are patentably distinct.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group I can be used in a materially different method such as immunopurification in addition to the materially different diagnostic methods of Groups III and IV.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;
(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
(d) the prior art applicable to one invention would not likely be applicable to another invention;
(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or

clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (571) 272-0827. The examiner can normally be reached at Monday through Friday from 8:00 AM to 6:00 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached at (571) 272-0832.

The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David J. Blanchard/
Primary Examiner, A.U. 1643